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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/408,447	09/29/1999	TSUKASA SAKO	862.3050	4061
5514	7590	02/17/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			KIM, CHONG R	
			ART UNIT	PAPER NUMBER
			2623	

DATE MAILED: 02/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/408,447

Applicant(s)

SAKO ET AL.

Examiner

Charles Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 79,94-97,106 and 109 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 79,94-97,106 and 109 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 10, 2004 has been entered.

Response to Amendment and Arguments

2. Applicant's amendment filed on November 10, 2004 has been entered and made of record.

3. Applicant's arguments filed November 10, 2004 have been fully considered but they are not persuasive.

Applicants argue (pages 26-27) that their claimed invention (claims 76, 77, 94, 95, 106, 109) differs from the prior art because "the Tabata and Endo patents are not seen to disclose or suggest at least the features of (i) acquiring information indicating a state of an X-ray irradiation or a photographed portion of an input image, and (ii) designating an outputting area, in image data obtained by computerizing the input image (or representing an image of a photographed object), to be outputted to the output medium, based on the acquired information." The Examiner disagrees. Tabata discloses the steps of acquiring information indicating a state (size) of an X-ray irradiation or a photographed portion of an input image (col. 16, line 62-col. 17, line

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8), and designating an outputting area, in image data obtained by computerizing the input image to be outputted to the output medium, based on the acquired information (col. 16, lines 9-10 and col. 16, line 62-col. 17, line 8). Therefore, Tabata appears to still be applicable to claims 76, 77, 94, 95, 106, 109, as amended.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 76-77, 94-95, 106, 109 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabata et al., U.S. Patent No. 5,774,232 ("Tabata").

Referring to claim 76, Tabata discloses an image outputting system for outputting image data to an output medium, the system comprising:

- a. an acquisition unit configured to acquire information indicating a state of a scanned portion of an input image (col. 16, line 62-col. 17, line 8. Note that the size of the document is interpreted as the information indicating a state of a scanned portion of an input image);
- b. designation unit configured to designate an outputting area in image data obtained by computerizing the input image to be outputted to the output medium, based on the

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information acquired by the acquisition unit (col. 16, lines 9-10 and col. 16, line 62-col. 17, line 8);

c. selection unit configured to select one of a plurality of output medium sizes (col. 16, line 62-col. 17. Note that an output medium size is selected before it is fed into the document feeding means);

d. determination unit configured to determine an output mode based on a relationship between the designated outputting area and the output medium size selected by the selection unit (col. 16, line 62-col. 17, line 8).

Tabata does not explicitly disclose that the scanned portion of the image comprises a photographed portion of the image. However, the Examiner notes that Tabata's scanned image and a photographed image are both considered image data. Furthermore, Official notice is taken that photographed image data was exceedingly well known and commonly used in the art. Therefore, since Tabata is concerned with obtaining image data, it would have been obvious to modify the scanned image of Tabata so that it is a photographed image. The suggestion/motivation for doing so would have been to increase the flexibility of the imaging system.

Referring to claim 77, Tabata further discloses that the determination unit determines an output mode based on whether or not the outputting area falls within an effective image area of the selected output medium size (col. 16, line 62-col. 17, line 8).

Referring to claim 94, see the rejection of at least claim 76 above.

Referring to claim 95, see the rejection of at least claim 77 above.

Referring to claims 106 and 109, see the rejection of at least claim 76 above. Tabata further discloses an imaging unit configured to image an object (document) and obtaining image data representing the image (col. 16, lines 9-13), but fails to explicitly disclose a photographing unit for photographing the object. However, the Examiner notes that Tabata's imaging unit and a photographing unit are both used to produce image data. Furthermore, Official notice is taken that a photographing unit for photographing an object was exceedingly well known and commonly used in the art. Therefore, since Tabata is concerned with obtaining image data, it would have been obvious to modify the imaging unit of Tabata so that it is a photographing unit for photographing an object. The suggestion/motivation for doing so would have been to increase the flexibility of the imaging system.

5. Claims 78-79, 96-97 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Tabata et al., U.S. Patent No. 5,774,232 ("Tabata") and Endo et al., U.S. Patent No. 6,335,796 ("Endo").

Referring to claim 78, Tabata further discloses that the determination unit includes a segmenting output mode where an outputting area is segmented into a plurality of segmentation areas and outputted to a plurality of output media (col. 16, line 62-col. 17, line 8).

Tabata fails to disclose that the determination unit includes a life-size output mode, a reduced image output mode, and an extraction output mode. However, these features were exceedingly well known in the art. For example, Endo discloses an output determination unit that includes a life-size output mode wherein an entire outputting area is outputted in an actual size (col. 10, lines 63-65), a reduction image output mode where an outputting area is reduced

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and then outputted (col. 11, lines 8-10), and an extraction output mode where a predetermined area is extracted from an outputting area and then outputted (col. 11, lines 2-8. Note that the “area of concern” in line 7 extracts a predetermined area such as the lung area to be output.).

Tabata and Endo are both concerned with outputting an image on different output medium sizes. Endo’s system reduces troublesome procedures on the part of the operator, thereby allowing the outputting to be performed optimally under various conditions (Endo, col. 12, lines 18-23). Therefore, it would have been obvious to modify the determination unit of Tabata, to include a life-size output mode, a reduced image output mode, and an extraction output mode, as taught by Endo, in order to enhance the output process.

Referring to claim 79, Endo further discloses that the determination unit determines that the output mode is one of the reduced image output mode, when an output medium size selected by a selection unit is not appropriate for the life-size output mode (col. 11, lines 20-33).

Referring to claim 96, see the rejection of at least claim 78 above.

Referring to claim 97, see the rejection of at least claim 79 above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Kim whose telephone number is 703-306-4038. The examiner can normally be reached on Mon thru Thurs 8:30am to 6pm and alternating Fri 9:30am to 6pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on 703-308-6604. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ck

February 10, 2005


Jon Chang
Primary Examiner